



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,895	03/31/2004	David Benjamin Auerbach	24207-10115	5766

62296 7590 02/20/2007
GOOGLE / FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA ST.
MOUNTAIN VIEW, CA 94041

EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
----------	--------------

2168

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,895

Applicant(s)

AUERBACH ET AL.

Examiner

Greta L. Robinson

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-36 are pending in the present application.
2. Claims 1, 18 and 35 have been amended; and new claim 36 has been added.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of claims 1-36 are directed to an abstract idea and does not include a useful concrete tangible result. The claims have been amended to include limitation for outputting results set; however the claim omits steps for actually "executing a search query" [see: claim 1 lines 8-10; claim 18 lines 9-12; claim 35 lines 10-16; and claim 36 lines 10-13].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. US Patent 5,742,816 in view of Chen US Patent 6,728,763 B1.

Regarding claim 1, **Barr et al.** teaches a method comprising: capturing one or more events having associated event data and associated with a client device, wherein each event is associated with an article and at least one of the articles is a media file, wherein at least one of the events is captured in real time upon the occurrence of the event [note: abstract a method and apparatus for identifying textual documents and multi-media files corresponding to a search topic; Figure 3; col. 12 lines 16-18 software 106 on PC 104 waits for the user to input a search query; col. 12 lines 46-53 upon receipt of the query by session server 114, processing proceeds to step 335, during which the search query is transmitted];

responsive to capturing the one or more events, indexing and storing at least some of the event data and articles associated with the events [note: Figure 3 (117)

Art Unit: 2168

document index database; Figure 6 (117); col. 12 lines 54-65 document index database 117 stores the document identification numbers corresponding to each document file (stored in database 118)];

receiving a search query [note: Figure 6 (134) query engine interface; Figure 6B step 142a receive query fields from search engine API 140; col. 13 lines 18-24, also note lines 39-42]; and

determining the at least one media file as relevant to the search query [note: col. 13 lines 18-24; Figure 6 note step (142L) transmit document identification and corresponding relevance scores to search engine API]; and

outputting a result set referencing the at least one media file [note: Figure 3 note PC 104 and software 106; column 14 lines 29-31 "user PC 104 together with software 106 display the search results list (or portion thereof)"].

Although Barr et al. teaches the invention substantially as cited above, they do not explicitly state that the data is captured in real-time. **Chen** teaches that conventional systems allow browsers to capture events such as media content from the web in real-time [note: column 1 lines 36-55]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Chen with Barr et al. since Barr teaches that his system is compatible with large volume networks such as the Internet for receiving and sending a search query [col. 8 lines 50-67].

7. Regarding claims 4 and 21, "wherein capturing the event data associated with the media files comprises monitoring a media application to determine event data

associated with the event and compiling the event from at least some of the event data ” [note: Barr et al. Figure 2 steps 208-210; Figure 6B steps 142J through 142L (i.e. performing search and outputting results is equivalent to capturing and compiling the event)].

8. Regarding claims 5, 6, 22, and 23 “wherein capturing the event associated with the media files comprises determining event data external to the media file ... determined based at least in part on one or more of a local database, global database, a web page, and a network search engine [note: Barr et al. col. 11 lines 29-45].

9. Regarding claims 7-11 and 24-28, “wherein the media file comprises an audio file ... video file ... image file ...” [Barr et al. abstract; column 13 lines 1-4].

10. Regarding claims 12-17 and 29-34, “wherein capturing the event associated with the media file comprises determining text that identifies the media file and including the text as event data associated with the event ... indexing the event ... identifying the event ... [note: Barr et al. col. 20 line 61 through col. 21 line 25].

11. The limitations of claim 18 parallels claim 1; therefore it is rejected under the same rationale.

Art Unit: 2168

12. Regarding claims 2, 3, 19 and 20, "wherein the search query is an explicit query" and "wherein the search query is an implicit query" note, Barr et al. does not explicitly state the type of query being executed; however, Barr et al's system would provide for both explicit and implicit queries because of its ability to dynamically execute a query in real-time. As taught by Chen conventional browsers have the ability to capture events and execute queries in real-time, implicit queries are generated based on ongoing events (i.e. real-time) in the background. It would have been obvious to one of ordinary skill at the time of the invention to have assumed that the search query of Barr et al. would provide for both types of search queries since Chen et al. teaches real-time execution of a query implies an implicit query and it is well known that most queries are explicit.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Barr et al. US Patent 5,742,816.

Regarding claim 35 Barr et al. teaches a method, comprising: "monitoring a plurality of applications to determine event data associated with a plurality of events

Art Unit: 2168

comprising media file events and non-media file events, wherein each event is associated with an article" [note: session/query server architecture column 20 line 36-41 "session server **software 114a** includes a plurality of session managers 130, each of which is responsible **for monitoring** and directing a single active user session 300"; also note column 21 lines 14-22 "The search engines 142 are each coupled to document index database 117, and schedulers 144 monitor and queue the searches performed by search engines"];

"compiling at least some of the event data to capture at least some of the media file events" [note: Figure 6 (134) query engine interface; Figure 6B step 142a receive query fields from search engine API 140; col. 13 lines 18-24, also note lines 39-42];

"responsive to capturing indexing and storing" [Figure 3 (117) document index database; Figure 6 (117); col. 12 lines 54-65 document index database 117 stores the document identification numbers corresponding to each document file (stored in database 118)];

"locating relevant articles from the indexed and stored event" [note: Figure 6 (134) query engine interface; Figure 6B step 142a receive query fields from search engine API 140; col. 13 lines 18-24, also note lines 39-42; col. 13 lines 28-29 system finds article or other text which the publisher 112 may have published];

"outputting a result set" [note: Figure 3 note PC 104 and software 106; column 14 lines 29-31 "user PC 104 together with *software 106 display* the search results list (or portion thereof)"].

Art Unit: 2168

15. The limitations of claim 36 have been addressed above in claim 35 except for “capturing the at least one event upon the occurrence of the event by queuing event data associated with the event at a position in a queue [note: Barr et al. teaches a queue in connection with monitoring search column 21 lines 14-25].

Response to Arguments

16. Applicant's arguments filed November 30, 2006 have been fully considered but they are not persuasive.

In response to the rejection cited under 35 USC 101, Applicant argued the claims have been amended to include limitation for outputting a result set referencing the at least one media file; however the examiner respectfully maintains the rejection because the claim omits steps for actually executing a search.

Applicant's arguments regarding the rejection cited under 35 USC 112 second paragraph are found convincing and the rejections have been withdrawn.

In response to the rejection cited under 35 USC 103(a) citing Barr et al. in view of Chen, Applicant states neither Barr et al. nor Chen teach how the document index database is created. Applicant states the references do not provide for capturing one or more events or indexing and storing responsive to receiving a search query.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a document index database is created) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Barr et al. does teach a document index database to identify documents see Figure 3 element (117); column 9 lines 8-15. also lines 40-43. The documents are retrieved in response to a search query.

The specification defines the limitation "capturing an event" as playing an audio file, editing a video, uploading an image, viewing a web page or saving a word processing document see **page 8 paragraph 0018**. Barr et al. provides for at least one of these type of events see Figure 4A; also note abstract a method and apparatus for identifying textual documents and multi-media files corresponding to a search topic; Figure 3; col. 12 lines 16-18 software 106 on PC 104 waits for the user to input a search query; col. 12 lines 46-53 upon receipt of the query by session server 114, processing proceeds to step 335, during which the search query is transmitted.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen et al. US Patent Application Publication No. 2005/0071322 A1

Art Unit: 2168

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2168

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greta Robinson
Primary Examiner

Greta Robinson
Primary Examiner
February 14, 2007